

**RECEIVED
CENTRAL FAX CENTER**

Application No. 09/736,232
Amendment dated July 5, 2006
Reply to Office Action of November 2, 2005

JUL 05 2006 Docket No.: 65856-0025
00-TRN-005

REMARKS

Applicant has carefully reviewed the Office Action mailed May 4, 2006. In response to the Office Action, Applicant has amended claims 12, 13, 15, and 16. Claim 8 was previously canceled. By way of this amendment, no new matter has been added. Accordingly, claims 1-7 and 9-21 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicant respectfully requests reconsideration of the present application in view of the above amendment, the new claims, and the following remarks.

Claim Rejections – 35 U.S.C. § 112

Claims 12-16 and 19-21 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. Specifically, the Examiner notes that the step of ‘determining a driveline inertia’ in independent claim 1, is not required and the step of displaying the driveline inertia is required. Accordingly, Applicant has amended independent claim 12 to require the step of ‘determining a driveline inertia’.

Claim Rejections – 35 U.S.C. § 102

Claims 7, 9, 10 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Eaton Corporation (Eaton), “DOS-Based Driveline Angle Analyzer (DAA) Screen Captures”, 1995 (Applicant mailed July 14, 2005, in response to Requirement for Information – 37 C.F.R. § 1.105, dated May 16, 2005), hereinafter “SCREEN CAPTURES”. Applicant respectfully traverses the rejections.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Application No. 09/736,232
Amendment dated July 5, 2006
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Docket No.: 65856-0025
00-TRN-005

"[T]he reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it" *In re Spada* 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Independent claim 7 positively recites "selecting a representative vehicle driveline from a plurality of saved driveline configurations." In contrast, SCREEN CAPTURES does not teach selecting a representative driveline. Thus, SCREEN CAPTURES does not teach every limitation of independent claim 7, as required in *In re Spada*.

Dependent claims 9, 10, and 18 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. As an example, claim 3 recites "wherein the graphical user interface program includes a corrective mode." These teachings are not taught in the prior art of record.

Claim Rejections – 35 U.S.C. § 103

Claims 1-5, 12-15, 17, and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eaton Corporation (Eaton), "DOS-Based Driveline Angle Analyzer (DAA) Screen Captures", 1995, hereinafter "SCREEN CAPTURES" in view of US Patent No. 5,848,371 to Creger, hereinafter "Cregger". Applicant respectfully traverses the rejection.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

All Elements

Independent claim 1 positively recites "entering measurements for the vehicle driveline configuration into a graphical user interface program." In contrast, neither SCREEN CAPTURES or Cregger teach entering measurements into a graphical user interface program, nor has the Examiner alleged that this limitation is taught in SCREEN CAPTURES or Cregger. Indeed, Cregger teaches away from a user interface and from entering data by teaching a diagnostic controller 110 that receives inputs from ECM 104 and ECM 112. Further, ECM 104

Application No. 09/736,232
Amendment dated July 5, 2006
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Docket No.: 65856-0025
00-TRN-005

and ECM 112 receive inputs from sensors, not from a user interface. Thus, neither SCREEN CAPTURES or Creger teach every limitation of independent claim 1, as required in *In re Royka*.

Independent claim 12 recites "displaying a driveline inertia of the desired vehicle driveline configuration." In contrast, neither SCREEN CAPTURES or Creger teach displaying a driveline inertia, nor has the Examiner alleged that this limitation is taught in SCREEN CAPTURES or Creger. Indeed, the Examiner has not alleged that SCREEN CAPTURES or Creger are capable of calculating a driveline inertia.

Motivation to Combine

A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner has combined SCREEN CAPTURES and Creger to reject the claims. As a motivation for the proposed combination, the Examiner identifies a purported motivation within Creger "because driveline torque is a useful value to monitor in predicting future problems as suggested by Creger." However, a motivation to combine must suggest the desirability of the combination. In contrast, the purported motivation identified by the Examiner does not suggest. One of skill would recognize that the inventions of SCREEN CAPTURES and Creger could be used separately within a vehicle since they perform entirely separate functions. Indeed, one of skill in the art would recognize that the torque calculated in Creger is of no benefit in the program of SCREEN CAPTURES. Also, the torsional acceleration of SCREEN CAPTURES is not beneficial to the calculation of torque in Creger. Importantly,

Application No. 09/736,232
Amendment dated July 5, 2006
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Docket No.: 65856-0025
00-TRN-005

the Examiner has not alleged that one of skill would use the torsional acceleration and torque as inputs within a common program, or that one could be a possible input for a program that calculates the other. Accordingly, one of skill may wish to utilize the inventions of SCREEN CAPTURES and Creger on the same vehicle, but would not have any motivation to unduly experiment on, or develop a program to combine, the two inventions, since the outputs of the two inventions are used separately for different purposes.

Furthermore, dependent claims 2-5, 13-15, 17, and 19-21, which depend from independent claims 1 and 12, include limitations that are not taught in the prior art of record. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Eaton Corporation (Eaton), "DOS-Based Driveline Angle Analyzer (DAA) Screen Captures", 1995, hereinafter "SCREEN CAPTURES". Applicant respectfully traverses the rejection.

When rejecting a claim based upon a sole 35 U.S.C. 103(a) reference, the Federal Circuit has provided some guidance. Specifically, *In re Gordon* provides that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, the Federal Circuit has held that "[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure." *In re Mills*, 16 USPQ2d 1430, 1433 (1990).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of SCREEN CAPTURES to teach every element of independent claim 7 is also fatal to the Examiners §103 rejection of dependent claim 11. As detailed above, SCREEN CAPTURES does not teach every limitation of dependent claim 7, as required in *In re Royka*, and accordingly, dependent claim 11 is patentable by being dependent on an allowable base claim.

JUL 05 2006

Application No. 09/736,232
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Docket No.: 65856-0025
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Furthermore, dependent claim 11 includes the limitation that the results are saved "as an image file." SCREEN CAPTURES makes no mention of saving as an image file. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes that no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65856-0025 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

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Respectfully submitted,

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